

REMARKS

This amendment responds to the office action mailed October 6, 2003. With this amendment claims 37-48 were added to recite embodiments of the invention in which a remote web service is a search engine (or, correspondingly, that each remote web service in a plurality of remote web services is a search engine). No new matter has been added by these additional claims. In the office action the Examiner:

- rejected claims 1-2, 5-9, 12-16, and 19-21 under 35 U.S.C. 102(e) as anticipated by Nagatomo (US Patent No. 6,487,557);
- rejected claims 34-36 under 35 U.S.C. 102(e) as anticipated by Alberts (US Patent No. 5,937,392);
- rejected claims 3-4, 10-11, 17-18, 22-23, and 25-31 under 35 U.S.C. 103(a) as being unpatentable over the teachings of Nagatomo in view of Alberts; and
- rejected claims 24, 32-33 under 35 U.S.C. 103(a) as being unpatentable over the teachings of Nagatomo, in view of Alberts, and further in view of Chris Sherman ("Google Introduces Web Directory Using Netscape's Open Directory Project Data").

The pending claims are claims 1-48.

THE 35 U.S.C. § 102(E) REJECTIONS SHOULD BE WITHDRAWN

The Examiner rejected claims 1-2, 5-9, 12-16, and 19-21 under 35 U.S.C. 102(e) as being anticipated by Nagatomo. The Examiner also rejected claims 34-36 under 35 U.S.C. 102(e) as being anticipated by Alberts. Applicants respectfully traverse these rejections.

Nagatomo does not teach each element of claims 1-2, 5-9, 12-16, and 19-21

Nagatomo does not anticipate claims 1-2, 5-9, 12-16, and 19-21. Nagatomo is directed to a network access management system that categorizes e-mail addresses and URLs accessed by a user based on frequency of historical use. The end product of Nagatomo can be viewed in Fig. 17 of Nagatomo, where E-mail addresses and URLs are categorized based on frequency of historical use. In contrast, claims 1-2, 5-9, 12-16, and 19-21 are directed to methods, computer program products, and computer systems for generating directed content based on the identity of remote web services that receive a given search string at high frequencies. For instance, using the example provided on page 12 of Applicants'

specification, consider the search string “napster.” Using the methods of the present invention, a determination is made that the web service “download.com” has received the search string “napster” with a relative frequency of 3853 whereas the web service “software.com” has received the same search string with a relative frequency of only 14. Therefore directed content, such as an advertisement, is generated based on the identity of the web service “download.com” (as opposed to “software.com”) since “download.com” received the search string “napster” with the highest frequency. The directed content can be, for example, an advertisement to use “download.com.”

Because Nagatomo cannot be equated to claims 1-2, 5-9, 12-16, and 19-21, there are a number of elements in these claims that are not disclosed in Nagatomo. For example, Nagatomo does not teach or suggest receiving a set of lists of any kind from a plurality of remote web services and, more particularly, does not teach **lists of search strings that have been submitted to a plurality of remote web services**. For instance, the first step claim 1 includes this limitation:

receiving a set of lists from a plurality of remote web services, each list in said set of lists associated with a respective web service in the plurality of remote web services and **each list in said set of lists including searches submitted to said respective web service;**

Since Nagatomo does not teach receiving a list of searches submitted to a respective web service, Nagatomo cannot possibly teach many of the other elements recited in claims 1-2, 5-9, 12-16, and 19-21, such as distilling the set of lists into a frequency database, searching the frequency database for a match between the *query* and a *search* in the database, or generating directed content based on one or more of the selected web services. A few of the elements recited in claims 1-2, 5-9, 12-16, and 19-21 that are not taught in Nagatomo are discussed in more detail below.

Nagatomo does not teach the receipt of lists from a plurality of remote web services, each list including searches submitted to a respective web service. Claims 1, 7, 8, 14, 15, and 21 recite that a set or plurality of lists are received from a plurality of remote web services. As described on page 6, lines 8-17, of Applicants’ specification, remote web services, including “engines such as CNET’s Shopper.com and Amazon.com’s Lawn & Patio Store,” send in lists to be aggregated into a database or sorted list. In complete contrast, as illustrated, for example, in Nagatomo’s Fig. 11, a list of URLs accessed by users is built over

time on access management server 110 (Nagatomo's Fig. 2) as such web sites are accessed. The lists shown in Nagatomo's Figs. 5 and 6, for instance, are **not** received from remote web services. Rather, these lists are generated on the fly by a network service provider, with data being added to a user's information (in the client database 120) as the user accesses various services. The portions of Nagatomo (col. 12, lines 32-46, col. 13, line 52 to col. 14, line 12, Fig. 6-Table 123) cited by the Examiner as being relevant to the *receiving* step of claim 1, concern the client database 120 and the information stored for each client. None of the data described in these portions of Nagatomo comprise lists received from web services, where the lists identify searches submitted to the web services, as required by independent claims 1, 8 and 15.

In Nagatomo, when a particular user enters a URL that the particular user has never entered before (elements S201-No, S203 of Nagatomo's Fig. 11), a record of this event is added to history table 122 (Nagatomo's Fig. 5) along with the user's identifier. When a particular user enters a URL that the particular user has entered before (elements S201-Yes, S202 of Nagatomo's Fig. 11), the access frequency for that URL is updated in a record in history table 122. In this way, each record in Nagatomo's history table 122 tracks the frequency that a particular URL has been accessed by a particular user associated with the record. History table 122 is used in Nagatomo to determine how URLs associated with a particular user in table 122 should be displayed on a client terminal associated with the user.

Thus, Nagatomo does not teach receiving a set or plurality of lists from a plurality of web services.

Nagatomo does not teach a set of lists that includes searches submitted to web services. Even if Nagatomo were somehow construed to teach receiving a set of lists from a plurality of remote web services, Nagatomo does not teach that such lists would contain "searches submitted to said respective web services" as indicated in claims 1, 7, 8, 14, 15, and 21. Such "searches" are the search queries that are submitted to, for example, web portals such as Google.com. They are illustrated in Applicants' Fig. 2 (search string 80-x-y), Fig. 3, Fig. 4 (user provides query terms 410), page 11, lines 11-29, and page 14, lines 2-5, of the specification. Nagatomo does teach the storage of web addresses provided by a user. However, the web addresses of Nagatomo cannot be equated to Applicants' searches. Applicants' searches (e.g., "napster", "presidential debate" from Applicants' page 11)

represent *queries for information* whereas the web addresses of Nagatomo represent *connection requests*.

For the reasons discussed above, claims 1, 7, 8, 14, 15, and 21 are not anticipated by Nagatomo, and are thus patentable. Claims 2, 5, 6, 9, 12, 13, 16, 19, and 20 depend from one of claims 1, 7, 8, 14, 15, and 21 and are therefore patentable for at least the same reasons that claims 1, 7, 8, 14, 15, and 21 are patentable over the cited art. Thus, Applicants respectfully request that the rejection to claims 1-2, 5-9, 12-16, and 19-21 be withdrawn.

Alberts does not teach each element of claims 34-36

One embodiment of Alberts is directed to an advertisement scheduler that determines the frequency by which advertisements are served. In particular, column 3, lines 22-25, of Alberts states that “[w]hen a user contacts one of web servers 12 with a query or a request for information, ad server 14 causes one or more ads to be served *along with* a response to that request” (emphasis added). In contrast, claims 34-36 are directed to collecting data generated by a remote web service in response to the query and generating a directed advertisement that *includes a portion of the response* in the advertisement. Thus, there is a fundamental difference between this embodiment of Alberts and Applicants’ claims 34-36. In Applicants’ claims 34-36 the directed advertisements include a portion of a response to a query directly in the advertisement. Page 15, lines 14-22, of the specification illustrate the concept:

For example, consider a case in which the query provided by a user during processing step 410 is “Harry Potter” during a period of time in which “Harry Potter” is a component of the title of a best selling paperback book. In all likelihood, an on-line book service such as Amazon.com will receive a high score during processing step 414 as numerous users request information on “Harry Potter” books. By routing the query terms “Harry Potter” to the Amazon.com query engine, the titles of available Harry Potter books are obtained and used as the basis of an advertisement that is transmitted to the client computer browser 54 for display during processing step 418.

In Alberts, the advertisements do not include a portion of a response to a search query. As can be clearly seen in Fig. 3 of Alberts, one embodiment of Alberts stores a database that includes advertisement identifiers 34 which, according to column 3, lines 37-41, of Alberts, is a URL or pointer to data (*e.g.*, graphical and/or textual object) that is to be provided to the user. Thus, it is clear that, in this embodiment of Alberts, the advertisements do not include a portion of the response to a search query and are in fact *predetermined*

whereas the advertisements indicated in claims 34-36 are dynamically generated as a function of search query results. Column 7, lines 7-32, of Alberts describes another embodiment of Alberts in which advertisements are selected as a function of the query. However, these advertisements are obtained from tables and do not include a portion of a response to a search query as recited in claims 34-36. As such, claims 34-36 are not anticipated by Alberts, and are thus patentable over Alberts. Therefore, Applicants respectfully request that the rejection to claims 34-36 be withdrawn.

THE REJECTIONS UNDER 35 U.S.C. 103(A) SHOULD BE WITHDRAWN

The Examiner rejected claims 3-4, 10-11, 17-18, 22-23, and 25-31 under 35 U.S.C. 103(a) as being unpatentable over the teachings of Nagatomo in view of Alberts. The Examiner also rejected claims 24, 32-33 under 35 U.S.C. 103(a) as being unpatentable over the teachings of Nagatomo, in view of Alberts and further in view of Chris Sherman. Applicants respectfully traverse the rejection.

Claims 22-33. Claims 22, 26 and 29 indicate the generation of a directed advertisement that *includes a portion of a response to a query*. The Examiner admits that Nagatomo does not teach this limitation. Further, as discussed in Applicants' response to the 35 U.S.C. § 102 rejection of claims 34-36, above, Alberts does not teach such a limitation either. Thus the combination of Nagatomo and Alberts cannot possibly render claims 22, 26, and 29 obvious. Claims 23-25, 27, 28, and 30-33 depend from claims 22, 26 and 29 and are thus patentable over the combination of Nagatomo and Alberts for at least the same reasons that claims 22, 26, and 29 are patentable over such combination of references.

Claims 3, 4, 10, 11, 17, and 18. Claims 3, 4, 10, 11, 17, and 18 respectfully depend from claims 1, 8, and 15. As discussed in Applicants' response to the 35 U.S.C. § 102 rejection above, Nagatomo fails to teach each and every limitation of claims 1, 8, and 15 because Nagatomo does not teach the receipt of lists from a plurality of remote web services or lists that include searches submitted to web services. Alberts fails to remedy the deficiencies in Nagatomo. Thus, the combination of Nagatomo and Alberts does not render claims 1, 8, and 15, or their dependent claims 3, 4, 10, 11, 17, and 18 obvious.

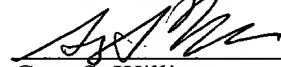
For the reasons discussed above, Applicants respectfully request that the rejection to claims 3-4, 10-11, 17-18, 22-33 be withdrawn.

CONCLUSION

In light of the above amendments and remarks, Applicants respectfully request that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at (650) 493-4935, if a telephone call could help resolve any remaining items.

Date: November 20, 2003

Respectfully submitted,



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